

REMARKS/ARGUMENTS

The Examiner states that the inventions of Groups I and II are related as mutually exclusive species in an intermediate-final product relationship under M.P.E.P. §806.04(b) and the intermediate product is deemed to be useful in and of itself without the requirement of the shaping methods in Groups II to produce a film.

However, it can be seen from the recitation of the claims of Groups I and II that the transparent heat resistant optical material is the same material in both of the claims of Groups I and II and the product by process limitations of the claims of Group II do not change or effect the basic nature of the material in Group I. Further, assuming arguendo that the inventions of Groups I and II are, in fact, different, the relationship would not be intermediate-final product, because the claims of Groups I and II are not species of one another and, further, the material of the intermediate does not lose its identity in the final product, as is typically the case with groups in an intermediate-final product relationship. The relationship, if the criteria set forth by the Examiner is accepted, would be combination-subcombination under M.P.E.P. §806.05(c), which requires two-way distinctness be demonstrated in order to establish that combination and subcombination inventions are distinct. Since two-way distinctness has not been demonstrated for the inventions of Groups I and II, it is requested that the claims of Groups I and II be rejoined and examined in the present application.

Further, Applicants traverse the Restriction Requirement on the grounds that the Patent and Trademark Office has not shown that a burden exists in searching all of the claims. Applicants respectfully point out that thousands of U.S. patents have issued in which many more than two subclasses have been searched, and the Patent and Trademark Office cannot reasonably assert that a burden exists in searching only two subclasses.

Application No. 10/663,667
Reply to Restriction Requirement of August 25, 2004

Accordingly, for the reasons presented above, Applicants submit that the Patent and Trademark Office has failed to meet the requirements necessary to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,

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